



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/541,391

07/01/2005

Hideyasu Matsumura

P28122

6325

7055 7590 10/21/2009
GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

RIOJA, MELISSA A

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

10/21/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

1 RECORD OF ORAL HEARING

2
3 UNITED STATES PATENT AND TRADEMARK OFFICE

4
5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES

8
9
10 *Ex parte* HIDEYASU MATSUMURA and YASUTAKA TSUTSUI

11
12
13 Appeal 2009-005987
14 Application 10/541,391
15 Technology Center 1600

16
17
18 Oral Hearing Held: Thursday, September 17, 2009

19
20
21
22 Before CHUNG PAK, PETER KRATZ and MARK NAGUMO,
23 *Administrative Patent Judges*

24
25
26
27 ON BEHALF OF THE APPELLANTS:

28
29 HERIBERT F. MUENSTERER, PH.D.
30 Greenblum & Bernstein, P.L.C.
31 1950 Roland Clarke Place
32 Reston, Virginia 20191
33
34
35

1 The above-entitled matter came on for hearing on Thursday,
2 September 17, 2009, commencing at 9:25 a.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, 9th Floor, Hearing Room A,
4 Alexandria, Virginia, before Leanne M. Krivonak, Notary Public.

5 JUDGE PAK: Mr. Muensterer, welcome.

6 It seems we have two related cases.

7 MR. MUENSTERER: Yes.

8 JUDGE PAK: And the second case, Calendar Number 53,
9 Appeal No. 2009-011671, seems to be a little bit more comprehensive in
10 terms of the claims. We may -- if you don't mind, start with Appeal No.
11 2009-011671, and then with Appeal No. 2009-005987, you will know, right
12 away when we discuss Appeal No. 2009-005987.

13 MR. MUENSTERER: Actually, if I may, I would prefer to
14 start with Appeal No. 2009-005987. That's Application Number Application
15 10/541,391, for reasons which I will explain to you very soon, if you don't
16 mind. And it shouldn't take very long to discuss the '391 Application, I
17 think. --

18 JUDGE PAK: Okay. You could start with Calendar Number
19 52, Appeal No. 2009-005987, first.

20 MR. MUENSTERER: I appreciate that.

21 JUDGE PAK: Then Appeal No. 2009-011671.

22 MR. MUENSTERER: Yes. Yes, because many of the things
23 that I -- I -- I will point out in the first case will also apply to the second
24 case, so you will not lose any time. I promise. And I don't expect to talk for
25 very long because it seems to be less complicated than --

1 JUDGE PAK: All right. Counsel, you may start any time soon.

2 MR. MUENSTERER: I just wanted to introduce the visitors
3 that came with us, Mr. Matsumura is one of the inventors and Mr.
4 Kadowaki, and he is also with the company, Patent Department, and this is
5 Ms. Yamamoto, she will be the translator. And if you don't mind, she will
6 be doing it in a very quiet way. And she will not do some intense
7 translation, but just to keep the witnesses abreast of what's going on here.

8 JUDGE PAK: Counsel, Do you know -- we decide our cases
9 on the record?

10 MR. MUENSTERER: Yes, I know.

11 JUDGE PAK: -- and we don't take any testimony --

12 MR. MUENSTERER: Oh, yes, I understand.

13 JUDGE PAK: -- at this hearing.

14 MR. MUENSTERER: I understand.

15 JUDGE PAK: Our court reporter here today will transcribe
16 everything they say and the resulting transcript becomes part of the record.
17 And whatever they say to their detriment would become part of the record
18 and such a statement could be used against them. You are fully aware of
19 that consequence --

20 MR. MUENSTERER: Yes.

21 JUDGE PAK: -- with that caveat --

22 MR. MUENSTERER: Yes.

23 JUDGE PAK: -- you could allow them to speak, but -- just for
24 the purposes of explanation only.

1 MR. MUENSTERER: No, the purpose -- simply is that, does
2 that -- should any technical questions come up from the Board that I would
3 not be able to answer, I would be able to quickly refer to the technical
4 people and ask -- and maybe they know -- just for that particular instance.
5 Otherwise, we have no plans on letting anyone speak other than myself.

6 JUDGE PAK: Oh, sure. You may start your argument.

7 MR. MUENSTERER: Okay. Thank you very much.

8 As I said, I requested that we start with the '391 application for
9 one particular reason, and it should become apparent very soon.

10 What I will do is go through the differences between the claims,
11 especially claim 1, and the disclosure of the main prior art document that the
12 Examiner relied on, that's Japanese reference. And in the course of that
13 presentation, I hope to make it apparent that there are various and very
14 important differences between the claims and the main prior art document.

15 Then we start with one difference, and I will not go into detail
16 what the claimed process is all about, because I can assume that the Board
17 already is familiar with all the details here.

18 But what I would like to point out -- and this is a difference that
19 applies also to the parallel case -- all of the method claims of the parallel
20 case have this element, too; namely, point one, 0.1 to 0.9 parts by weight of
21 a polymerization initiator relative to one hundred parts by weight of this
22 styrene-based monomer. That's, as I said, is in both in claim 1 of this case
23 and also in the main methods claim of the other cases.

24 We've already submitted in writing that Takamasa explicitly
25 teaches 1.0 to 3.0 parts of polymerization initiator.

1 Takamasa actively and actually states a preferred amount would
2 be even higher, 1.1 parts per hundred parts of the monomer. And as I said,
3 we noted --

4 JUDGE PAK: Counsel, we note that in the translation provided
5 to you on page 6 --

6 MR. MUENSTERER: It's a clerical error.

7 JUDGE PAK: The amount of polymerization initiator used at
8 that page is 0.1 to 3 parts by weight?

9 MR. MUENSTERER: Yes, yes.

10 JUDGE PAK: Although just below it, Takamasa mentions 1.0
11 to 3 parts by weight.

12 MR. MUENSTERER: Yes, I'm aware of this, and I think
13 everyone could understand that this can only be either a translation error or a
14 typographical error because this point -- this 1.0 to 3.0 appears not only in a
15 claim of Takamasa, but also in several other places. And that's one of the
16 things that I -- I would like to point out.

17 And in a way it's very unfortunate, you said that translation was
18 provided to us, but only after we had filed our Reply Brief. We were never
19 able to -- to really discuss the translation. Although the Examiner had the
20 translation since October of 2007 after having issued the First Office Action,
21 but she already had the translation. She not only relied on it and -- but we
22 didn't have it either. We only had the abstract.

23 And that's why I -- I think a very important passage of this
24 translation we were not aware of, and that's why I would like to point it out

1 to you. And this is at page -- in the paragraph, first two pages 9 and 10 of
2 the translation.

3 It starts at Line 5 from the bottom of page 9. Again, the amount
4 of polymerization initiator that being used is 1.0 to 3.0 parts by weight,
5 preferably 1.1 to 2.0 parts by weight to the vinyl polymer by parts by weight.

6 Now the important passage of the translation: If the amount is
7 less than 1.0 parts by weight, the dispersed particle diameter of the vinyl
8 aromatic polymer in the enhanced polyethylene group resin particles being
9 obtained is large, and in the foamed molded body being obtained by pre-
10 forming said particles and further heating and molding them, not only its
11 rigidity is not improved, but the impact resistance intrinsic to the
12 polyethylene group resin is damaged.

13 I cannot think of any clearer teaching away from using less than
14 1.0 parts by weight of polymerization initiator than this passage.

15 JUDGE PAK: So the Examiner's reliance on the *Titanium*
16 *Metal* case in which a prima facie case of obviousness was held to be
17 established based on the close proximity of the amounts of ingredients
18 involved, because there was a reasonable expectation that the resulting
19 products will have the same properties goes away.

20 MR. MUENSTERER: This goes away, yes.

21 It's clear teaching away. It's not just nonobvious for providing
22 no known reasons for modifying the amount taught by Takamasa, but it is a
23 clear teaching away. I mean, let me make it clear.

24 What they say is if you use these beads to make molded
25 articles, you will not improve the impact -- you will not improve the rigidity,

1 which is the main purpose of using the styrene monomer and polymerizing it
2 within the beads.

3 JUDGE PAK: Counsel, let's move on to product claim 4.

4 MR. MUENSTERER: Yes. Well, this is -- this is
5 another -- okay, I just wanted to make clear that this is an element in all of
6 our method claims that is clearly part away. So, okay.

7 So let's move on to the product claims.

8 This is another -- another teaching away that we were not aware
9 of. The product -- product Claim 4 says that the expandable beads
10 have -- the base resin of the expandable beads contains more than 300 parts
11 by weight and less than thousand parts by weight of a polystyrene-based
12 resin component.

13 Well, you -- you are probably well aware of the fact that, again,
14 Takamasa says to use 5 to 300 parts by weight, and actually it even says
15 preferably only 200 parts by weight per hundred parts per weight of the non-
16 crosslinked leanear low-density polyethylene-based resin component.

17 Again, the translation is much clearer about this and gives the
18 reasons why more than 300 parts by weight of a polystyrene-based resin
19 component are not desirable.

20 And in this case I would like to refer you to the last paragraph
21 at page 8 of the translation. Let me read it, with your permission. The
22 amount of vinyl aromatic molymer is 5 to 300 parts by weight, preferably 30
23 to 200 parts by weight to the polyethylene group resting at hundred parts by
24 weight.

1 If the amount is more than 300 parts by weight -- if the amount
2 is more than 300 parts by weight, the vinyl aromatic molymer is not
3 uniformly, entirely absorbed by the polyethylene group resin, and the
4 monomer that is not absorbed is polymerized alone, which is not preferable.

5 Okay. That's one reason.

6 But then, meaning the beads cannot absorb all the monomer if
7 you use more than 300, and as a result, you will get polymerization outside
8 the beads. You will have powder, polystyrene powder outside the beads
9 under -- under -- and that's also explained in our application that this is not
10 desirable.

11 That's already a reason not to use 300 parts by weight.

12 But it goes on.

13 Also, the polyethylene group resins that has absorbed a large
14 amount of vinyl aromatic monomer loses the properties intrinsic to the
15 polyethylene.

16 So, the teaching is even if you were aware -- able to make the
17 polyethylene beads absorb more than 300 parts by weight of monomer per
18 hundred parts by weight of beads, it wouldn't be desirable because you
19 would lose the properties that are intrinsic to the polyethylene. Most
20 probably you would impair the impact resistance of the article.

21 JUDGE PAK: Well, Counsel, contrary to the process involving
22 a polymerization initiator where you use 10 percent less than the amount
23 taught by Takamasa --

24 MR. MUENSTERER: Yes, uh-huh.

1 JUDGE PAK: The lowest percentage of the polymerization
2 initiator used in the prior art included in Claim 4 --

3 MR. MUENSTERER: Yes.

4 JUDGE PAK: -- you are using a base resin containing more
5 than 300 parts by weight of a styrene monomer component, which could
6 include one part per billion -- I mean one part per billion or trillion, so it
7 could be practically a negligible amount more than 300 parts by weight.

8 Am I correct in saying this thing?

9 MR. MUENSTERER: I don't know whether you are correct,
10 but what I can tell you is that the issue here is not, do we have to show any
11 unexpected properties or anything?

12 The issue simply is: Is the claimed amount rendered obvious
13 by Takamasa, that is, use more than 300 parts by weight. That's the only
14 issue. Is it -- is it obvious from Takamasa or on the contrary, does Takamasa
15 teach away from using more than 300 parts by weight?

16 I'm not -- I'm not willing to go into details what -- what the
17 advantages would be of -- of -- of slightly more than 300 parts by weight.
18 It's just a question -- is this a prima facie case of obviousness using more
19 than 300 parts by weight despite the reference teaching expressly against it?

20 I would agree with you that if Takamasa only said, you know,
21 you use 300 parts by weight, not more than 300 parts by weight, giving no
22 reason whatsoever, could be a close case.

23 I agree, but here we have two reasons -- two actual reasons why
24 you shouldn't use it. The first is if you use it, the polymers will not -- that

1 the monomer will not be completely absorbed. That's also what we have
2 pointed out in our application.

3 And the second reason -- and I think even more important -- is
4 that Takamasa says if you use more than 300 parts by weight, you will lose
5 some of the good properties of the polyethylene. And by the way, you
6 should not use more than 200 anyway. It says preferably you should only
7 use 200 parts by weight.

8 So, I think this is the issue here. Is it obvious, and is it a prima
9 facie case of obviousness if a reference teaches expressly away from using
10 more than 300 parts by weight. Is it obvious then to use more than 200 parts
11 by weight? That's the only issue I think that needs to be decided here.

12 JUDGE NAGUMO: There is somewhat of a technical
13 question, and if you could clarify it for us. And that is the meaning of
14 this -- in Claim 1 of 4 -- the 2 to 40 weight percent of gel component
15 comprising a graph in copolymer and to distinguish --

16 MR. MUENSTERER: Yes.

17 JUDGE NAGUMO: -- that from the other type of gel
18 component --

19 MR. MUENSTERER: Yes. Yes.

20 Well, it's explained actually in the application, but I -- I
21 understand. It's somewhere hidden in the application. What it says is that
22 you will always have -- the gel component defined as being the insoluble
23 component if you try to dissolve the resin beads after the polymerization of
24 polyethylene at 130 degrees Centigrade or whatever is not dissolved is
25 considered to be the gel component.

1 And what also --- it said in our application is that while this gel
2 component could be two different things, it could be cross-linking of the
3 polyethylene beads or the polyethylene within the -- that would make it
4 insoluble. Or it could be a grafted co-polymer where the polystyrene is
5 grafted onto the polyethylene.

6 And in the specification, this is defined, if you take this
7 insoluble fraction, dry it, and then decompose it and determine by, actually
8 gas chromatography, the polystyrene content; and if the polystyrene content
9 is more -- or the styrene content in this case, then it's more than 10 percent,
10 it's considered to be a grafted polymer rather than just the cross-linked
11 polyethylene.

12 JUDGE NAGUMO: Okay. I just wanted to clarify in my own
13 mind then if the specification at page 4 -- actually, this is from the other
14 application, but I think they're substantially the same as far as the -- it says
15 hereinafter the term "graft polymer" means the gel component containing
16 polystyrene. And the term "cross-linked polymer" means the gel component
17 substantially, not containing polystyrene.

18 This is intended to be strictly the graft co-polymer rather than
19 polystyrene that might be generated, because you've got styrene monomers
20 and it --

21 MR. MUENSTERER: Yes, yes, yes.

22 JUDGE NAGUMO: So, that's -- that really doesn't happen --

23 MR. MUENSTERER: We draw, no, we draw the line and we
24 say if it's -- if you have this gel and it has more than 10 percent of
25 polystyrene, we say this is a graft rather than a cross-link.

1 My understanding is that it may still have traces of cross-linked
2 polyethylene in there, too, but it's defined as --

3 JUDGE NAGUMO: My point is slightly different.

4 It could have, perhaps, should pure polystyrene in there. Is that
5 swept into the -- into the this definition of --

6 MR. MUENSTERER: No, no, no, the polystyrene is -- if you
7 have --

8 JUDGE NAGUMO: What would that be --

9 MR. MUENSTERER: -- polystyrene not grafted, it will be
10 soluble in the styrene --

11 JUDGE NAGUMO: Thank you.

12 MR. MUENSTERER: And, you know, this is -- and thank you
13 actually for pointing that out because Claim 4 not only talks about the more
14 than 300, it also talks about the gel content that needs to be above 2 -- or it
15 needs to be at least 2 percent.

16 And the reason for that is also illustrated in the various samples,
17 because if you have a very slow -- a very low gel component, the
18 improvement in the physical properties of the polyethylene beads is not that
19 large.

20 It is still okay, and this is actually the reason for the other case,
21 but the -- if the gel component is at least 2 percent, you get better physical
22 properties, impact resistance, compression, compressive strength, and
23 also -- and also thermal stability.

24 I -- I don't think we have the time to go into details here, but if
25 you look at a comparison between -- well, I mean, of course the gel

1 component is not there for no reason. You have to have it. It is there
2 because of the other -- the other conditions that are mentioned in claim 1, for
3 example, namely the temperatures -- the polymerization temperature, the
4 two-step conversion of the styrene monomer and also the point at which the
5 conversion of -- at which -- which point of the polymerization of the
6 ongoing polymerization, the second batch of monomer is added.

7 If you would like -- for example, this would have been another
8 argument for -- with respect to the -- to the process claims or the method
9 claims in the two-step case where -- where the claims -- in both applications
10 say you add the styrene monomer only after you have reached 80 percent
11 conversion because we have one example or a comparative example in
12 this -- in this application where 60 percent conversion verses 80 percent
13 conversion compared and it shows you that the properties are much better if
14 you wait 'til you have 80 percent conversion.

15 Also, maybe even a better case is where a comparison of
16 Comparative Example 1 and Example 1 where the gel fraction is
17 significantly different just because the temperature of the polymerization is
18 different by 2 degrees Centigrade, and will get at a low -- in this case, the gel
19 fraction is .3 in one case and 7.2 in the other case. And you can see
20 compressive strength, impact strength, and temperature resistance become
21 much worse or at least worse if you have less than -- if you actually lower
22 the gel component maybe only .3 percent.

23 JUDGE PAK: Counsel, so what about the obviousness type
24 double patenting rejection between these two applications?

1 MR. MUENSTERER: Yes, that is another issue. When you
2 look at the claims, they differ at least in that the temperature ranges in which
3 the -- the -- the polymerization is carried out are different.

4 And that makes a big difference. And that is also explained in
5 the comparative examples and examples. You get -- you get a different gel
6 content in one case and you know, just to -- to -- to illustrate what -- what
7 the difference in -- in gel content can be in -- depending on the temperature,
8 unfortunately, this comparison would be for the one-step process; but I think
9 it illustrates something.

10 If you look at Figure 1 of the companion case, you will see
11 what gel content one would expect. Well, if you raise the temperature, then
12 you get a higher gel content more or less a linear relationship, but when you
13 look at Figure 1, you'll see that there are -- there is a temperature range
14 where you get a high gel content and this is all in the claims and the relation
15 to the melting point of the polyethylene. You get a peak in Figure 1 you can
16 see it's about at 118. It starts to go up way high, but then it comes back
17 again after about 10 degrees Centigrade. You are back to a relatively low
18 gel content. And that's why we have these different temperature ranges.

19 In the one case where we want a high gel content, we -- we
20 have -- we have the temperature range basically where the peak is. And in
21 the cases where we want the low gel content, we have the two temperature
22 ranges which afford a low gel content.

23 And let me maybe explain to you also why in one case we have
24 the high gel content and in the other case we want a gel content that is low.
25 And it is explained in the application, but it may not be so apparent.

1 As I've already pointed out, the gel content determines, in a
2 way, the physical properties of the polyethylene beads. I mean, the
3 improvement.

4 If you have a lower gel content, you will get an improvement,
5 but it will not be so -- so pronounced.

6 If you have a -- on the other hand -- and that is explained in the
7 Application in the companion case -- if you have a -- it has something to do
8 with recycling. If you want to recycle -- this is all mainly based -- used for
9 packaging materials, for -- for high -- high -- highly -- high-valued articles
10 like as to these screens and so on where you need a high-impact resistance, a
11 high compressive strength and everything, but once you have used the
12 packaging material, obviously you would like to be able to recycle it.

13 How is the recycling done? Usually you -- you put everything
14 into a melt extruder, melt it, and then extrude it. You have a strand of
15 molten polymer that goes through your extruder.

16 Then you take the strand, cool it, and then you cut it into small
17 pellets, and the pellets can now be used for new -- for making new articles.

18 The problem with the gel content here is that -- that the gel
19 content particles or the gel particles will not melt. So what it means is the
20 higher the gel content, the higher is the discontinuity in your strand, which
21 means that there are particles in there that are not molten, and they constitute
22 breaking points for the strand.

23 So what happens is if you have a lot of these gel content
24 particles in there, theoretically you recognize for the physical properties the
25 physical properties, not so good for recycling because your strand will break,

1 and break, and break, but that's something that you really don't want. And
2 that's the reason why in the companion case we use a gel content that is still
3 enough to get you improved properties, but not high enough to cause real
4 problems with recycling.

5 So, well, is there anything else that you would like me to talk
6 about with respect to the 391 case?

7 I can also -- I could go on. As I have already pointed out, the
8 differences with respect -- with respect to the processes are mainly the
9 amount of polymerization initiator, the amount of styrene monomer relative
10 to the polyethylene beads, the two-step process, the addition of additional
11 monomer in the course of the polymerization but not -- but not at any point
12 of the polymerization, but only after you have already have an 80 percent
13 conversion, and then, of course, the lack of any teaching in Takamasa that
14 the polymerization temperature plays any role.

15 If you look at the polymerization temperature and what it said
16 about the polymerization temperature in Takamasa, you won't find much.
17 All I could find is that Takamasa says at one point it should be high enough
18 to decompose -- to sufficiently decompose the polymerization initiator.

19 I would have assumed without any teaching that this should be
20 the case, but that's -- that's basically all that is taught in Takamasa about
21 polymerization temperature -- no appreciation whatsoever that with the
22 polymerization temperature, especially in relation to the melting point of
23 polyethylene beads --

24 JUDGE PAK: But, Counsel --

25 MR. MUENSTERER: -- you can control a lot of properties.

1 JUDGE PAK: Takamasa uses a temperature of 115 degrees --

2 R. MUENSTERER: Uh-huh.

3 JUDGE PAK: -- for the polymerization.

4 MR. MUENSTERER: Uh-huh. Uh-huh.

5 JUDGE PAK: How is that different from your 115 degree
6 temperature?

7 MR. MUENSTERER: No, I am not saying that this is
8 different. It is within the claimed range in the -- in the -- in the '391
9 application, but it could as well be outside. There is no teaching -- I mean,
10 this is just an additional difference, but there is no indication in Takamasa
11 that 115 degrees is important as long -- it probably is controlled by the
12 decomposition temperature of the -- of the initiator that they used in
13 Takamasa. That what would be in accordance with what Takamasa says,
14 use a polymerization temperature that is high enough to sufficiently to
15 decompose your initiator and I assume 115 degrees is high enough.

16 JUDGE PAK: Thank you, Counsel.

17 Let's move on to the second case --

18 MR. MUENSTERER: Yes.

19 JUDGE PAK: -- Appeal Number 2009-011671.

20 MR. MUENSTERER: Uh-huh.

21 JUDGE PAK: And you have 20 minutes. Hopefully you don't
22 use all that, but you can start any time you wish.

23 MR. MUENSTERER: Yes -- no, I'm prepared, and you know,
24 it's essentially almost a repetition of what I've already said.

1 For example, with the process claims or the method claims,
2 both the two-step and the one-step we have .1 to .9 parts by weight of
3 polymerization initiator per hundred parts by weight of vinyl aromatic
4 monomer. And that is -- that is clearly discouraged by Takamasa.

5 So, I -- I think I could always, with respect to the method
6 claims, I could always stop here because I cannot think of any clearer
7 teaching away from an invention.

8 JUDGE KRATZ: Would you have any objection to us just
9 creating one transcript and putting it in both files?

10 MR. MUENSTERER: I think that's -- yes, that makes it easier
11 because then it's clear what I said. And I already mentioned a lot of things
12 that apply for -- yes, I agree. That would be the best thing to do.

13 JUDGE KRATZ: So, is there anything else to add that you
14 have beyond what you said to the -- about the first case here? Taking in
15 mind what you already said, what do you have to add with respect to this
16 case?

17 MR. MUENSTERER: Yes, I mean -- yes, I -- as I said, I can
18 only repeat many of these arguments, and I don't think it's really necessary to
19 go -- I can point out to you the passages again of Takamasa -- the
20 translations that clearly teach away from -- from using less than 1.0 parts by
21 weight of polymerization, but it's already in the record that --

22 JUDGE NAGUMO: I --

23 MR. MUENSTERER: Excuse me. The translation is not of
24 record in this case. That's the problem.

1 JUDGE NAGUMO: Well, actually, my question goes to that
2 point in a way. We see a lot of this where a translation does not enter into
3 the record until very late in the proceedings.

4 When the applicant has no reasonable access to the translation,
5 if the translation had been in Swedish, or something, then the Applicant here
6 wouldn't have any way -- any reasonable way -- just by accident somebody
7 happened to see that.

8 But here the Applicants would probably be in a better position
9 to read and understand the reference than a professional translator who is not
10 a professional chemist.

11 There are -- I recognize there are difficulties and expenses, but
12 how do we deal with this situation generally? In other words, the Examiner
13 sends a rejection based on a Japanese language reference in this case, and
14 yet you feel very constrained to rebut the rejection, even though the full
15 reference appears to contain a very strong argument.

16 What is the perspective from your side of counsel on this sort of
17 issue?

18 Because this is not a problem that should have been here, I'm
19 sure you've experienced, at any time.

20 MR. MUENSTERER: Yes.

21 JUDGE NAGUMO: All of us have, too.

22 MR. MUENSTERER: You know, the -- to be quite frank, the
23 main issue is always the consideration -- how much would it cost. And will
24 the -- will the benefits justify the cost later, which is not easy to see from our
25 perspective.

1 We could, of course, go back to our client and say, can you take
2 a closer look at the Japanese document, if there's anything in that that will
3 help us? But then Japanese clients are not familiar with your U.S. patent
4 law. How would -- I -- I would not bet a penny that if we had asked our
5 clients to do that, that they would have -- you know, there is something in
6 there that -- that clearly teaches the way.

7 They are not usually -- especially the technical people are not
8 usually qualified or trained in patent matters, let alone in U.S. patent matters.
9 So how can they know that this is a clear teaching away and that this would
10 be very helpful to us?

11 In this case particularly, I frankly felt that we had a relatively
12 good position already. And this is just a bonus, in my opinion, that we now
13 have the translation and have even stronger arguments.

14 But in my opinion we already had a relatively strong position,
15 and so I hesitated even more to tell them we provide us with a translation.
16 And that is a lengthy document. That's another thing -- plus we had -- I
17 think it's on file -- a machine translation. Unfortunately, the machine
18 translations -- you cannot pick these details. It's good enough to get an idea
19 of what -- what is -- what is in the document, but not usually especially if it
20 comes down to these very specific details, even if I -- I mean, -- I probably
21 read it -- the machine translation, but simply read over it because it usually
22 doesn't make a lot of sense.

23 And it's usually really the financial considerations especially in
24 these relatively hard economic times. You don't want to burden your client
25 with costs that may later turn out to be unnecessary.

1 JUDGE PAK: It's really a difficult situation for the office with
2 respect --

3 MR. MUENSTERER: But, you know, in this case the
4 Examiner was aware of the translation, and she had it for -- she had it shortly
5 after -- my suspicion is she saw the -- the abstract and then she decided,
6 well, I could probably strengthen my case by having a full translation. She
7 ordered it after she had issued the First Office Action.

8 And then she looked at it and she decided it's worthless for her;
9 I can't understand why -- and simply forgot to send it to us. I mean,
10 this -- I'm almost certain we would not be here today --

11 JUDGE PAK: Counsel, let's not get into a speculative --

12 MR. MUENSTERER: No, no, no, no. I'm just saying if we
13 had had the translation, we could have saved the Board a lot of work.

14 JUDGE PAK: Yes, but Counsel, let's not speculate on what the
15 Examiner did unless you have absolute proof of it.

16 MR. MUENSTERER: No, I don't, but I mean, the date of the
17 translation is correct, is October --

18 JUDGE PAK: If you have any other argument --

19 MR. MUENSTERER: No, no --

20 JUDGE PAK: -- then thanks for coming.

21 MR. MUENSTERER: No, no, I -- I -- I -- well, yes, as I said,
22 I've already talked about -- especially for a two-step process everything that
23 I've said in the -- for the one-step process applies except for the amount of
24 styrene monomer, but in this -- in this case the temperature that is used in the
25 example is outside the range we recited in, for example, claim 3.

1 So, this is more or less difference and one more difference.
2 And for the -- for the one-step process, again, we have this difference with
3 the polymerization initiator and the clear teaching away and again the
4 temperature.

5 JUDGE PAK: All right, Counsel, I think we understand your
6 arguments and we will take your arguments into consideration in our
7 decision-making process. And we thank you for coming.

8 MR. MUENSTERER: Thank you very much for listening.

9 Whereupon, at approximately 10:06 a.m., the proceedings were
10 concluded.